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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,262	06/12/2000	KIYOHICO UCHIDA	99807MN	3573

466 7590 08/08/2003

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EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 08/08/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary

Application No.

09/486,262

Applicant(s)

UCHIDA ET AL.

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-23 is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/7/03 has been entered.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed (ie. both the product and process of making).

The following title is suggested: - Paper Feed Roller and Method of Manufacture - -.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. **Claims 1 and 2** are rejected under 35 U.S.C. 102(b) as being anticipated by Fuchs et al. (5,257,965).

Fuchs et al. teach that it is known in the prior art to use a paper feed roller (in col. 1, lines 59-68 to col. 2, lines 1-3, Fuchs et al. specifically describes the roller features of German Patent Disclosure Document DE 36 17 316A1, note that the DE 36 17 316 A1 document is cited in the attached PTO-892) comprising: a rotary shaft, and a cylindrical roller that comprises a mixture of hydraulic composition (col. 1, line 61) comprising a hydraulic powder (col. 1, lines 61-62 and lines 64-65; ie. “cements” consist of hydraulic powder which cure with water) and a non-hydraulic powder (col. 1, lines 67-68 to col. 2, line 1; ie. “fly ash” or “particles of crushed rock” are non-hydraulic powders) and a workability improver (col. 2, line 1; ie. “additives” or “activators”), the cylindrical roller portion being integrated with an outer periphery of the rotary shaft, wherein the workability improver is a material that has a property of improving moldability, mold-releasability, cutting/grinding workability, and grinding accuracy of the molded body obtained from the hydraulic composition because Fuchs et al. teach the claimed structural features of the roll. It is noted that “improving moldability”, “mold-releasability”, “cutting/grinding workability”, and “grinding accuracy” do not further limit the structural limitations of the claimed roll. For example, cutting and grinding are process steps that could be performed after the roller is made. However, the invention is directed to the product itself, ie. the roll, and these limitations do not add structure to the claimed product.

It is noted that in applicant’s response filed 7/7/03, page 7, lines 7-26 to page 8, lines 1-5, applicant states that one of the “additives” or “activators” that is used in DE 36 17 316 (the document Fuchs et al. refers to), is a water-reducing agent. Applicant also explains that water-

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reducing agents pertain to cement and cites a document entitled "Cement Chemistry" by H.F.W. Taylor (a copy of the "Cement Chemistry" document is attached to the end of applicant's response filed 7/7/03). The "Cement Chemistry" document that applicant refers to clearly states: "Water-reducing agents, also called plasticizers, allow a given degree of workability to be achieved...". Therefore, it is noted that Fuchs et al. clearly teach the claimed "workability improver".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 3-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuchs et al.

Fuchs et al. describes the prior art roller described above (Fuchs et al. specifically describes the DE 36 17 316 A1 document in col. 1, lines 59-68 to col. 2, lines 1-3).

Fuchs et al. does not specifically teach that the DE 36 17 316 A1 reference is formed by connecting a plurality of cylindrical molded bodies in a direction of the rotary shaft.

However, Fuchs et al. teach connecting a plurality of cylindrical molded bodies **4** in a direction of the rotary shaft **3** in fig. 1A.

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Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the prior art roller described by Fuchs et al. in col. 1, lines 59-68 to col. 2, lines 1-3, with a plurality of cylindrical molded bodies in a direction of the rotary shaft, in light of the teachings of Fuchs et al., in order to provide roller sections that can be easily replaced without replacing the entire roller body as suggested by Fuchs et al. at col. 3, lines 43-45.

Regarding claims 4 and 5, note the connecting core rod 14 and the end portions have interengaging shapes 5.

With respect to Claim 6, Fuchs et al. teach the invention cited with the exception of the hydraulic composition having the claimed ranges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the claimed ranges, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With respect to Claim 7, Fuchs et al. teach the invention cited with the exception of using the claimed workability improvers.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have used the claimed workability improvers because applicant has not disclosed that using the claimed workability improvers provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either the workability improver taught by Fuchs et al. or the claimed workability improvers because both improvers perform the same function of increasing workability. Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have

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selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Allowable Subject Matter

7. **Claims 8-23** are allowed.

Response to Arguments

8. Applicant's arguments filed 7/7/03 have been fully considered but they are not persuasive.

9. Applicant argues that the instant invention has nothing to do with the ordinary additive or activator (water reducing agent as in the DE 36 17 316 document which Fuchs et al. describes in the specification section of Fuchs et al.), however, the additive or activator that is disclosed by Fuchs et al. are still a type of workability improver as noted in the citations above. The rejected claims do not preclude additives or activators as the workability improver. It is noted that the roll described by Fuchs et al. is capable of being subject to cutting or grinding. Because of the use of additives or activators (water reducing agent), the cement is easily cast in a mold, producing an improved, more accurate, shape of the desired roll configuration. Because the additives or activators help produce a roll that has an improved shape, the cutting workability is also improved because one would cut a roll that has a more accurate shape instead of cutting a roll having a distorted shape. It is easier to accurately cut a symmetrical roller than one that is not.

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The grinding accuracy is also improved because the roll that is being ground has a more accurate shape.

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the claimed paper feed roller is a roller required to accurately feed papers in printers, facsimiles, copiers, etc.") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Contact Information

11. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The

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examiner can normally be reached on **Monday-Friday, between 5:30 am- 2:00 pm.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/


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MJ

August 7, 2003